



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Bachand, et al.

Serial No. : 09/150,692

Filed : September 10, 1998

Title : LABELLESS, ROLLED FOOD ITEM AND  
ITS FABRICATION

Docket No. 5137 (9649/105)

Group Art Unit: 1761

Examiner: D. Becker

Commissioner for Patents and Trademarks  
Washington, D.C. 20231

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COMMISSIONER OF PATENTS AND TRADEMARKS,  
WASHINGTON, D.C. 20231, ON JUNE 12, 2001. (37 CFR 1.8a)

*Alan D. Kamrath*

APPEAL

Dear Sir:

This is an Appeal from the rejection of the Office communication mailed September 2, 2000  
in the above-identified application.

The claims on appeal are appended hereto.

A check for \$310 is enclosed to cover the appeal brief fees. The Commissioner is authorized  
to charge any deficiency or credit any over-payment to Deposit Account 50-1188.

Appellants hereby request an oral hearing.

As requested by the Office, and for the convenience of the Board, Appellants' Brief is  
presented in triplicate.

Respectfully submitted,

Bachand, et al.

By

*Alan D. Kamrath*

Alan D. Kamrath, Reg. No. 28,227  
Rider, Bennett, Egan & Arundel, LLP  
333 South Seventh Street  
Suite 2000  
Minneapolis, Minnesota 55402  
(612) 340-8925  
(612) 340-7900 facsimile

DATED: June 12, 2001

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APPELLANT'S BRIEF

Dear Sir:

In response to the Office communication mailed September 12, 2000, appellants wish to appeal the rejections of Examiner Becker.

(1) REAL PARTY IN INTEREST

The present application has been assigned to General Mills, Inc., a Minnesota corporation.

(2) RELATED APPEALS AND INTERFERENCES

None.

(3) STATUS OF CLAIMS

Claims 11-13 are indicated as being withdrawn from consideration. Claim 14 is rejected under 35 U.S.C. § 102. Claims 1-10 and 15-20 are rejected under 35 U.S.C. § 103(a).

(4) STATUS OF AMENDMENTS

The claims as originally filed were amended in an AMENDMENT filed February 29, 2000 in response to an August 25, 1999 official action to eliminate the word "step" from the

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claims. The claims were amended in an AMENDMENT filed August 28, 2000 in response to an April 24, 2000 official action to overcome a rejection under 35 U.S.C. § 112. Claims 2 and 14 were amended in an AMENDMENT AFTER FINAL REJECTION mailed on January 12, 2000 to overcome a rejection under 35 U.S.C. § 112. Efforts were taken to personally interview this application after the September 12, 2000 official action, but the request for a personal interview was denied.

(5) SUMMARY OF THE INVENTION

A rolled food item (110) is fabricated by rolling a strip of support material (16) and food (14) of an elongated length in the preferred form of 36 inches (one meter) about its leading end (136) into a roll. In the preferred form, the food (14) is in the form of a sweetened dehydrated fruit based material, and the support material (16) is in the form of silicon parchment paper. Prior to its rolling into the roll, a deposit (144) of food grade water free of adhesive type additives is sprayed onto the food (14) adjacent to the trailing end (138) for a length approximately 10% of the elongated length of the strip of support material (16) and food (14). The deposit (144) defines a first portion of the food (14) having a moisture content greater than the moisture content of the remaining portion of the food (14) to increase the tackiness of the food (14) within the first portion sufficient for the food (14) to be adherable to the support material (16) in the roll to at least temporarily prevent unintentional unrolling of the roll during later fabrication operations. In the preferred form, the trailing end of the deposit (144) is coextensive with the trailing end (138) of the strip of support material (16) and food (14). In one form, the side edges of the deposit (144) are spaced inwardly from the side edges of the food (14) which are spaced inwardly from the side edges of the support material (16).

(6) ISSUES

Is claim 14 unpatentable under 35 U.S.C. § 102(a) as being anticipated by WO97/33822? Are claims 1-4 and 15 unpatentable under 35 U.S.C. § 103(a) as being obvious from WO97/33822? Are claims 5-10 and 16-20 unpatentable under 35 U.S.C. §

103(a) as being obvious over WO97/33822 in view of the Assignee's prior Patent No. 5,853,836.

(7) GROUPING OF CLAIMS

- (a) claim 14;
- (b) claims 1 and 2;
- (c) claims 3, 5, 15 and 16;
- (d) claim 4;
- (e) claims 6, 7, and 16;
- (f) claims 8, 17 and 20;
- (g) claims 9 and 18; and
- (h) claims 10 and 19.

(8) ARGUMENT

Background

The Assignee of the present invention has enjoyed considerable market success in the sale of a novelty food item in the form of a strip of support material and food rolled into a coil. Prevention of unrolling during fabrication was a well known problem to the assignee who has been extensively commercializing the rolled food item of the type of the present invention for a number of years and recognized the need for a solution. Labels are one solution to this problem, but labels resulted in other problems. Patent No. 5,853,836 (Zoss) is a solution to the problems created by labels. Zoss is commonly assigned as the present application and was cited at least at page 2, line 11 and following of the present application. The present invention presents a solution to the unrolling problem by removing the need for labels and thus also eliminates the problems solved by Zoss, and specifically the need is removed for the labels per se either of the type of Zoss or of prior types.

The disclosure of Zoss at least at column 1, lines 31-38 and of page 2, lines 1-21 of the present application was based upon inspection of product on the market manufactured by Farley Candy Company. International Publication No. WO97/33822 is assumed to disclose

the manner of manufacture of that product. Attention is directed to the disclosure thereof wherein it discloses "a system for applying a drop of corn syrup" (page 16, lines 14 and 15, emphasis added); "when triggered, they [nozzles 110] each dispense one drop of corn syrup" (page 16, lines 31 and 32, material in brackets and emphasis added); "the drop of corn syrup is placed in the correct spot" (page 16, line 37-page 17, line 1, emphasis added); "deposit the drop" (page 17, line 2, emphasis added); "the ball valve allows a drop of corn syrup to pass out of the nozzle 110" (page 17, lines 13-14, emphasis added), and the like. In WO97/33822, "The adhesive then adheres the trailing end of the food product to the next outermost layer as the roll is formed, and holds it in this position while the roll is packaged" (page 16, lines 7-10) (emphasis added).

Cherukuri (Patent No. 4,352,825) teaches that chewing gum of a certain water content becomes "unacceptably sticky and tacky" and discloses coextruding the higher moisture gum inside of an outer shell portion. There is no disclosure that it is desirable for high moisture coated gum to be used to adhere anything, and in fact specifically teaches that high moisture content gum is "sticky and tacky and therefore difficult to package". There is no disclosure in Cherukuri that water should be sprayed on the chewing gum after formation.

(a) Claim 14

The Examiner contends "WO97/33822 teach [sic] the use of edible adhesives (page 16, line 5). Water is known to tackify confections and cause them to become sticky, as shown by Cherukuri (column 1, line 23), and also is an edible material. Therefore, water would fall under the general category of "edible adhesive" used by WO97/33822. Regardless, even an adhesive such as corn syrup would inherently possess a certain amount of water" (emphasis added).

It is respectfully submitted that there are many premises in this contention which do not support a rejection under 35 U.S.C. § 103. First, does Cherukuri suggest that water is an "edible adhesive"? It is respectfully submitted that Cherukuri would teach that chewing gum having a high moisture content would be "sticky and tacky" or in other words is an "edible

adhesive”, and specifically would not suggest water is an edible adhesive. It is then respectfully submitted that the combination of Cherukuri with WO97/33822 according to the Examiner’s reasoning would suggest using high moisture chewing gum rather than corn syrup as the edible adhesive.

Second, the Examiner contends that “Cherukuri is merely relied upon to show that it was known that water tackifies confections.” Does the Examiner contend that water will tackify all confections of any kind? The only confection discussed in Cherukuri is chewing gum. It should be noted that in the most preferred form, food 14 is a sweetened dehydrated fruit-based material (claims 9 and 18). In particular, food 14 has a moisture content that enhances its shelf life and particularly does not result in undesirably degrading during normal storage times before consumption (page 8, line 19 and following of the present application). In particular, if the moisture content was too high, food 14 may degrade such as by molding (page 11, lines 27-35 of the present application). It is believed that this is one of the reasons that corn syrup or similar adhesive was previously utilized, as the adhesion was based upon the qualities of the corn syrup and not the food itself and the moisture content of the food was not significantly increased.

Third, claim 14 recites “with the first portion of the food having a moisture content greater than the moisture content of the second portion and so the tackiness of the food is sufficient for the food to adhere to the support material in the roll . . . .” Specifically, as set forth in the specification of the present application at least at page 8, line 19 and following, while the food in the second portion has a moisture content that enhances shelf life and does not result in degrading, the food in the first portion has increased moisture content to become sticky or in other words has a tackiness such that the food itself (not including an additive or adhesive) secures the food to the support material. It should then be appreciated that although corn syrup of WO97/33822 includes moisture so that it can be contended that the total moisture present in the rolled food item is greater, there is no disclosure that such moisture is absorbed or transferred to the food such that the food has an increased moisture

content or that corn syrup increases the tackiness of the food itself sufficient for the food to adhere to the support material in a manner as the present invention. Rather, the corn syrup itself “can cool to a tacky state . . .” and “. . . will then be tacky . . .” (page 16, lines 23 and 24 of WO97/33822) and adheres to the food and to the support material.

Additionally, why would a person skilled in the art even consider the Cherukuri disclosure? In particular, although disclosing high water content chewing gum is “unacceptably sticky and tacky”, Cherukuri does not suggest that water should be added to increase adherence of a food to a strip of support material or that water can be utilized to prevent unintentional unrolling of a roll (whether formed of food or formed of food and a strip of support material as in the present invention). It is respectfully requested that the Examiner identify why a person skilled in the art would consider Cherukuri absent the hindsight teachings of the present invention. In particular, since Cherukuri does not provide any teachings relating to adhering food to a support material or to the creation of a rolled food item, why would a person skilled in the art even consider Cherukuri to be relevant to problems in the field of the present invention absent the hindsight knowledge of the present invention. As stated by the CCPA in *In re Van Wanderham, Worthley, and Comolli*, 154 USPQ 20, 24, 25 (1967):

Closely related to the doctrine of nonanalogous art is the doctrine forbidding hindsight reconstruction, also discussed in Potts, supra. In applying section 103, the Supreme Court recently cautioned against “slipping into hindsight.” (case citations)

\* \* \*

The opinion in *Sporck* further provides, 49 CCPA at 1043, 44, 45; 133 USPQ at 363, 364:

Once appellant’s solution to the problem of making a tapered wall frusto-cone is disclosed, it is easy to see how the prior references can be modified and manipulated to produce this type of cone. The change admittedly is simple and by hindsight seems obvious. However, the simplicity of new inventions is oftentimes the

very thing that is not obvious before they are made.

\* \* \*

It is of course true that the examiner was able to locate the Sato article. However, it appears that this was done through reading into the art the teachings of appellants' invention. In *re* Murray. We think the Patent Office's conclusion of obviousness is based on an impermissible hindsight reconstruction of the art. In *re* Sprock.

Our determination here is not without difficulty. However, we think the difficulty arises from not considering the subject matter as a whole and instead of focusing on the scientific principle involved . . .

Likewise, the CCPA stated in *In re Shapleigh*, 115 USPQ 129, 133 (1957):

The test as to whether two references are from non-analogous arts is whether one seeking to solve a problem with respect to the embodiment of a reference in one art would be apt to seek the solution to said problem in the other art. (case citation)

Similarly, the CCPA in *In re Antle*, 170 USPA 285, 287-288 (1971) stated:

In Winslow we said that the principal secondary reference was "in the very same art" as appellant's invention and characterized all the references as "very pertinent art." The language relied on by the solicitor, quoted above, therefore, does not apply in cases where the very point in issue is whether one of ordinary skill in the art would have *selected*, without the advantage of hindsight and knowledge of the applicant's disclosure, the particular references which the examiner applied. As we also said in Winslow, "Section 103 requires us to presume full knowledge by the inventor of the *prior* art *in the field of his endeavor*" . . . but it does not require us to presume full knowledge by the inventor of prior art *outside* the field of his endeavor, i.e., of "non-analogous" art. In that respect, it only requires us to presume that the inventor would have that ability to select and utilize knowledge from other arts reasonably pertinent to his particular problem which would be expected of a man of ordinary skill in the art to which the subject matter pertains. (emphasis theirs)

In determining what is analogous art, the Court of Appeals for the Federal Circuit stated in *Union Carbide Corp. v. American Can Co.*, 724 F.2d 1567, 220 USPQ 584 (1984):



In resolving the question of obviousness under 35 U.S.C., § 103, we presume full knowledge by the inventor of all the prior art in the field of his endeavor. However, with regard to prior art outside the field of his endeavor, we only presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved. The rationale behind this rule precluding rejections based on combination of teachings from references from nonanalogous arts is the realization that an inventor could not possibly be aware of every teaching in every art. Thus, we attempt to more closely approximate the reality of the circumstances surrounding the making of an invention by only presuming knowledge by the inventor of prior art in the field of his endeavor and in analogous arts.

The determination that a reference is from a nonanalogous art is therefore twofold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved.

Furthermore, even if the references relied upon by the Examiner were known for some reason, it should be appreciated that the reasons provided by the Examiner to show that the alleged modifications to WO97/33822 are based upon the hindsight knowledge of the present invention for the sole basis of attempting to meet the recitations of the claims. Specifically, the CAFC in *Environmental Designs, Ltd., v. Union Oil Co. of Cal.*, 218 USPQ 865, 870 (1983) stated:

All the pieces of the present invention were known in the art, . . . That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is however, simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art. (Case citations.)

Further, the CAFC in *In re Gordon*, 221 USPQ 1125, 1127 (1984) stated:

The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. (Case citations.)

Similarly, the Court of Appeals for the Federal Circuit in *In re Sernaker*, 702 F.2d

989, 217 USPQ 1, 5 (1983) stated:

We may assume, for purposes of this decision, that all the prior art references in this case are sufficiently related to one another and to a related and common art, that the hypothetical person skilled in the art must be presumed to be familiar with all of them. That being so, the next questions are (a) whether a combination of the teachings of all or any of the references would have suggested (expressly or by implication ) the possibility of achieving further improvement by combining such teachings along the line of the invention in suit, and (b) whether the claimed invention achieved more than a combination which any or all of the prior art references suggested, expressly or by reasonable implication.

Likewise, as stated by the CCPA in *In re Kamm and Young*, 172 USPQ 298 at 301

and 302:

The rejection here runs afoul of a basis mandate inherent in Section 103--that "a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure" shall not be the basis for a holding of obviousness. *In re Rothermel*, 47 CCPA 866, 870, 26 F.2d 393, 396, 125 USPQ 328, 331 (1960). "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Wesslau*, 53 CCPA 746, 750, 353 F.2d 238, 241, 147 USPQ 391, 393 (1965). We think this has been done here.

We appreciate the relative ease with which one can slip into such an error, especially where, as here, the primary reference addresses the same problem as appellants and solves it using merely a different chemical agent. However, we are satisfied that when the secondary references are viewed in their entirety, with due consideration given to what they fail to disclose and what they disclose as undesirable, it is evident that the proposed modification of the primary reference would not have been obvious to one of ordinary skill in the art at the time the invention was made.

Turning to the present application, WO97/33822 discloses the use of edible adhesive such as corn syrup. There is no disclosure of any suggestions of any other modifications or the desirability of such modifications in WO97/33822. A person skilled in the art considering Cherukuri would not be suggested to utilize water sprayed adjacent to the trailing edge but would be taught to increase the moisture content of all the food which would be consistent with the teachings of Cherukuri and then to provide an outer coating or to utilize high moisture chewing gum as an edible adhesive. Only the present invention provides the hindsight teachings necessary to select just the right elements and combine them in just the right way to arrive at the recitations of the claims.

It is then respectfully submitted that the rejection of the claims and in particular claim 14 and the claims which depend therefrom has been overcome. Favorable consideration is respectfully requested.

(b) Claims 1 and 2

Claim 1 has a similar recitation as claim 14 and thus is believed to be in condition for allowance for the same and similar reasons. Additionally, claim 1 recites "spraying a deposit of a source of moisture . . ." WO97/33822 discloses dispensing, placing, or depositing a drop of corn syrup. The Examiner contends that it would be obvious to spray the edible adhesive of WO97/33822 "since spraying the edible adhesive would produce a greater area of surface coverage for the edible adhesive thereby creating a stronger bond which would resist unrolling better than a single drop." However, there is no disclosure that the corn syrup or other "edible adhesive" is sprayed or has the ability to be sprayed. Additionally, the Examiner has failed to in any way support the contention that more is stronger. In this regard, WO97/33822 suggests a drop, no more. Further, if more is present, negatives result including affecting taste, texture, and/or appearance, being messy, and being difficult to work with as set forth at least at page 2, line 17 and following and page 12, line 10 and following of the specification of the present application. The Examiner has not set forth any prior art evidence that more than a drop is desirable or for that matter even a possibility. It is then

respectfully submitted that the basis for contending that "spraying" would be obvious is based solely upon hindsight reconstruction based upon the present invention. Reconsideration of the rejection of claims 1 and 2 is respectfully requested for this separate and independent reason.

(c) Claims 3, 5, 15 and 16

These claims are directed to the deposit of a source of moisture being approximately 10% of the elongated length of the strip of food and support material. As set forth at page 6, line 13 of the specification, in the preferred form, the elongated length is in the order of 36 inches (1 meter) or in other words the deposit has a length of 3.6 inches. This preferred length insures that sufficient adhesion strength exists to prevent unrolling during fabrication while minimizing the possibility of the degradation of the food in the rolled item as the result of the increased moisture content in the first portion including but not limited to molding. The Examiner has not in any way supported that it would be desirable to apply corn syrup greater than a drop or to apply corn syrup to any size. Thus, the sole basis for this rejection is the hindsight knowledge of the present application. Favorable consideration is respectfully requested for this separate and independent reason.

Further and even assuming that a person skilled in the art considered Cherukuri as being pertinent to the problem faced by the food item of WO97/33822, Cherukuri would teach fabricating the entire length of the food with an increased moisture content as there is no teaching in Cherukuri that water would be provided on less than the entire length and area. Thus, it is respectfully submitted that the rejection of claims 2, 3, 14, and 15 and the claims which depend therefrom has been overcome for this separate and independent reason. Favorable reconsideration is respectfully requested for this separate and independent reason.

(d) Claim 4

This claim relates to the use of food grade water free of adhesive type additives. The Examiner contends that it would be obvious "to use water free of adhesives with the invention of WO97/33822 since WO97/33822 teach [sic] the use of an edible adhesive, of

which water is a type as evidenced by Cherukuri et al. [Pat. No. 4,352,825] which teach [sic] the additional tackiness and stickiness of confections when an increased moisture content is present (column 1, line 23)". Initially, it should be noted that WO97/33822 does not suggest (and it would appear that the Examiner will concede) that water can be used as an adhesive with the invention disclosed therein. It is conceded that chewing gum having a high moisture content is "sticky and tacky". However, there is no disclosure that this "sticky and tacky" characteristic of chewing gum could be utilized to adhere the chewing gum to a strip of support material for purposes of fabrication of a food item. It should then be appreciated that the express teachings of Cherukuri would lead a person skilled in the art away from the present invention and would suggest that increased tackiness is "unacceptable" and would suggest if present, to include a shell portion to encapsulate the unacceptable tacky material to prevent adherence. It is then respectfully submitted that Cherukuri does not face or solve the problems presented in the field of the present invention. Favorable reconsideration is respectfully requested for this separate and independent reason.

(e) Claims 6, 7 and 16

Similarly, claims 6 and 16 further recite that the deposit is spaced inwardly from the side edges of the food (which in the preferred form are spaced inwardly from the side edges of the strip of support material). Clearly, a person skilled in the art would not be suggested by WO97/33822, Zoss and/or Cherukuri to arrive at the recitations of claims 6 and 16. Thus, it is respectfully submitted that the rejection of claims 6 and 16 and the claims which depend therefrom has been overcome for this separate and independent reason. Favorable reconsideration is respectfully requested for this separate and independent reason.

(f) Claims 8, 17 and 20

WO97/33822 discloses depositing the drop (125) of edible adhesive adjacent the trailing end and, at page 17, line 3, specifically discloses the drop is spaced ½ inch from the trailing end. Claims 8 and 17 recite that the trailing edge of the sprayed deposit is coextensive with the trailing edge of the strip of food, which is not suggested in

WO97/33822, and due to the negatives which result from the use of corn syrup, it is assumed that it would be desirable to avoid even the possibility of corn syrup being located on the leading edge of the next strip which would then have a greater tendency to undesirably collect on the roll-up device. Cherukuri provides no suggestion as to spraying and to specifically whether, when, or where to spray. Favorable consideration is respectfully requested for this separate and independent reason.

(g) Claims 9 and 18

As Cherukuri discloses the use of increased moisture content for chewing gum, it is respectfully submitted that Cherukuri provides no suggestion as to the use of water for sweetened dehydrated fruit-based material as recited in claims 9 and 18. It is then respectfully submitted that the rejection of claims 9 and 18 has been overcome for this separate and independent reason. Favorable reconsideration is respectfully requested for this separate and independent reason.

(h) Claims 10 and 19

Similarly, as Cherukuri does not disclose the use of high moisture content chewing gum for adhering, it is respectfully submitted that Cherukuri provides no suggestion as to the use of water to adhere increased tackiness food to silicon parchment paper as recited in claims 10 and 19. It is then respectfully submitted that the rejection of claims 10 and 19 has been overcome for this separate and independent reason. Favorable consideration is respectfully requested.

(9) CONCLUSION

Therefore, since the claims of the present application have been shown to include limitations directed to the features of applicants' labelless, rolled food item and its fabrication which are neither shown, described, taught, nor alluded to in any of the references cited by the Examiner, whether those references are taken singly or in any combination, the Board of Appeal is requested to reverse the rejection of the Examiner, to allow claims 1-10 and 14-20 of the present application, and to pass this application to issue.

Respectfully submitted,

Bachand, et al.

By



Alan D. Kamrath, Reg. No. 28,227  
Rider, Bennett, Egan & Arundel, LLP  
333 South Seventh Street  
Suite 2000  
Minneapolis, Minnesota 55402  
(612) 340-8925  
(612) 340-7900 facsimile

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